

REMARKS

Applicants thank the Examiner and his supervisor, Gary Kunz, for discussing the restriction requirement with the undersigned during the telephonic interview on January 22, 2003.

Applicants would like to once again draw the Examiner's attention to the fact that the correspondence address for the attorneys of record for this application is Fish & Neave, 1251 Avenue of the Americas, New York, NY 10020-1104. In support of this request, applicants with their August 29, 2002 reply, submitted as Exhibit B a copy of the Reply to Notice to File Missing Parts including the Declaration and Power of Attorney for Patent Application ("Reply"), filed in this application on March 10, 2000. However, for the convenience of the Examiner, applicants resubmit herewith a copy of that Reply as Exhibit A.

THE RESTRICTION REQUIREMENT

The Examiner has required that applicants elect a single patentably distinct sequence for each monomer comprising: a finger 1 subdomain, a finger 2 subdomain, a heel subdomain and a C-terminal cysteine skeleton. The Examiner states that applicants are required to elect a single sequence from SEQ ID NO: 40-63, 83 and 87 for each of finger 1 and heel subdomains. The Examiner states that each of the different sequences are independent and distinct because no common structural or functional properties are shared. Therefore, the Examiner concludes that the sequences are subject to restriction under 35 U.S.C. § 121. The Examiner further states that applicants are required to elect a single polypeptide sequence, which if determined to be

patentable, would also be patentably distinct from the other polypeptide sequences.

Applicants respectfully traverse the restriction. As discussed during a telephonic interview on January 22, 2003, between the Examiner, the Examiner's supervisor, Gary Kunz, and the undersigned, applicants believe that the restriction is improperly drawn. Applicants request that the proteins encompassed by the currently pending be examined together. The Manual of Patent Examining Procedure (MPEP) states that there are two criteria for a proper requirement of restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed. The second is that there must be a serious burden on the Examiner if restriction is not required. The MPEP further states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions". MPEP § 803.

Whether the Examiner is correct in his "distinctness" contention is irrelevant. Here, there is no serious burden for the Examiner to search all the proteins encompassed by the currently pending claims because as discussed with the Examiner and his supervisor, it is possible to devise a single search strategy to encompass all the proteins included in the claims. Moreover, according to the Examiner's restriction, applicants would have to file an excessively large number of patent applications which would be prohibitively expensive. Finally, applicants further submit that such a restriction would prevent applicants from being entitled to a generic claim.

During the telephone conference, the Examiner's supervisor, Gary Kunz, recommended that applicants request that the Examiner reinstate the original restriction/species election issued on December 12, 2000 and March 28, 2001 and that was initially reinstated by the former Examiner in the March 11, 2002 office action.

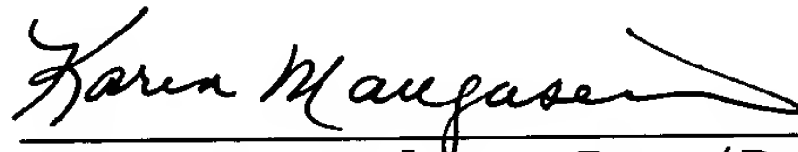
Accordingly, applicants request that the Examiner reinstate the restriction/species election issued on December 12, 2000 and March 28, 2001. Applicants maintain their election of the Group I invention directed to protein comprising a dimer wherein the monomers are chimeras of TGF- β superfamily members, wherein the finger 2 subdomain is cDMP-2 (residues 68-98 of SEQ ID NO:86) and the finger 1 and heel subdomains are from a second, different member of the TGF- β superfamily. Applicants further elect the species wherein finger 1 is residues 2-29 of SEQ ID NO: 55 (hOP-1), the heel is residues 35-65 of SEQ ID NO:55 (hOP-1) and finger 2 is residues 68-98 of SEQ ID NO 86 (CDMP-2) and the C-terminal cysteine skeleton of OP-1 (SEQ ID NO: 55).

However, pursuant to 37 C.F.R. § 1.143, applicants provisionally elect the following sequences for each monomer: the finger 1 domain of hOP-1 (residues 2-29 of SEQ ID NO: 55), the heel domain of hOP-1 (residues 35-65 of SEQ ID NO: 55), and the finger 2 domain of CDMP-2 (residues 68-98 of SEQ ID NO: 86), and the C-terminal cysteine skeleton of hOP-1 (SEQ ID NO: 55) for initial substantive examination. This election is expressly without waiver of applicants' right to continue to prosecute and to obtain claims to the non-elected subject matter in divisional or continuing applications claiming priority herefrom or from a related application under U.S.C. § 120.

CONCLUSION

In view of the foregoing remarks, applicants respectfully request consideration and early allowance of the pending claims in this application.

Respectfully submitted,



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